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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/382,426
Filing Date: August 24, 1999
Appellant(s): PHILYAW ET AL.

Mr. Gregory M. Howison
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/6/2008 and correction dated 5/15/2008
appealing from the Office action mailed 4/5/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

See Item 7 below.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-29 from the application are pending, stand firmly rejected , and are on appeal here...

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,005,939	Fortenberry et al.	12-1999
5,960,411	Hartman et al	09-1999
6,311,214	Rhoads	10-2001
5,913,203	Wong et al	06-1999

Official Notice

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11,14-17,19-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry (US 6,005,939) in view of Hartman (US 5960411).

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In regards to claim 1-11,14-17,19-24 and 27 the combination of Fortenberry and Hartman teach a method of processing profile information of a user for conducting an on-line transaction between the user and a vendor (abstract), comprising the steps of:

- entering profile information of a user into a profile form at a user location disposed on a network prior to conduction of an on-line transaction between the user and the vendor (Fortenberry, col 7, lines 39-45),

- the vendor disposed at a vendor location on the network (2a, item 210);

- issuing to the user a unique code representing stored profile information of the user in response to the user transmitting the profile form from the user location to a second location on the network for storage thereat (Fortenberry col 7, lines 45-65),

- the second location disposed on the network (Fortenberry FIG 2a, item 216);
- initiating an on-line transaction by selecting a product of the vendor at a user location (Fortenberry col 8, lines 29-31);

- after selecting the product, providing to the vendor location by the user the unique code for purchase of the product during the on-line transaction (Fortenberry col 8, lines 31-33),

- providing the stored profile information from the second location to the vendor location in response to the vendor location receiving and processing the unique code (Fortenberry col 8); and

Fortenberry teaches passing information from a third party to a vendor to process a transaction after receiving a unique identifier authorizing the release of sensitive information to a vendor (Fortenberry col 8, lines 29-31), but does not specifically mention inserting released information into a form automatically before submittal to a user. Hartman teaches automatically filling a confirmation webpage at a server which includes user sensitive information for processing the order (Hartman, FIG 6 and 1C). It would have been obvious to a person having ordinary skill in the art at the time of the invention to generate the web page at the vendor and sending it to the user, because this will be more efficient by eliminating a step and the need for additional software for filling in the web page on the user computer after sending information to the user and sending the web page to the user separately. Further, it would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Fortenberry the confirmation page of Hartman, because this was a notoriously well known means for presenting a final order summary that assures the user that the vendor has the order correct.

In regards claim 8, the combination of Fortenberry and Hartman teach wherein the step of automatically inserting causes only a portion of the profile information to be entered into the vendor payment form as encoded information (Hartman, FIG 1C).

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Claims 13,18, 26,28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry in view of Hartman and further in view of Rhoads (US 6,311,214).

In regards to claims 13, 18,26,28 and 29, the combination of Fortenberry and Hartman teach providing a unique code to the user for accessing a second server from a vendor, but does not specifically mention that the unique code is a barcode on a credit card. Rhoads teaches that the unique code is placed on a credit card (Rhoads, col 1, lines 35-40). It would have been obvious to a person of ordinary skill in the art to include in Fortenberry and Hartman the improvements as cited in Rhoads, because utilizing existing infrastructure, along with the convenience of having the access code readily available will provide for increased usage of the system and therefore increased revenue.

Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fortenberry in view of Hartman and further in view of Rhoads (US 6,311,214) and further in view of Official Notice.

In regards to claims 12 and 25, the combination of Fortenberry, Hartman and Rhoads teach a second location, but does not specifically mention that the second location is a credit card company server. The examiner takes official notice that it was old and well known in the art at the time of the invention to utilize credit card servers as a server for storage and dissemination of credit card information. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in the combination of Fortenberry and Hartman the use of a credit card company to store and disseminated the information, because this is a notoriously well known place to store this type of information and preventing these companies from participating in the invention of Fortenberry would reduce the potential sales market and reduce revenues.

(10) Response to Argument

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Further, hindsight is not improper if the combination would yield predictable results to one of ordinary skill in that art (MPEP 2143).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has used teachings, suggestions or motivations that were well known in the art.

Further, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness.

In response to applicant's argument that Fortenberry, Hartman and Rhoads is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443

(Fed. Cir. 1992). In this case, all of the references Fortenberry, Hartman and Rhoads deal with the purchasing of product over the internet.

Appellant suggests that the rejection was not clear since the reference cited did not precede the citation. The appellant none the less correctly identified Fortenberry as the correct reference. For clarity the examiner has added the Fortenberry reference before the citation in the rejection supra.

In regards to claim 1, appellant argues that Fortenberry does not teach "entering profile information into a profile form at a user location disposed on a network. The examiner disagrees and directs appellant's attention to FIG 4, where the user enters information into a form that is presented in respond to the query.

Appellant argues that Fortenberry does not teach "issuing to the user unique code representing stored profile information of the user in response to the user transmitting the profile form". The examiner disagrees and notes that clearly the public key is a unique code that provides accessibility to the provided data and since the key opens the data it represents the data in that it is uniquely associated with opening the data.

Appellant argues that Fortenberry does not teach the user initiates an on-line transaction by selecting a product of the vendor at the user location. The examiner disagrees and points out that FIG 5, item 502 clearly depicts the vendor requesting a transaction. Therefore, by way of requesting the entry of a customer order, where a product has been selected, the transaction as initiated indicates that a product had been

selected at some previous time and at what the appellant calls the initiation of the transaction.

Appellant argues that Fortenberry does not teach "after selecting the product, providing to the vendor location, by the user, the unique code for purchase of the product during an online transaction. The examiner disagrees and directs the appellants' attention to col 8, lines 40 through 47 where the vendor is submitting a message from the user containing a specific release type based on a unique "MY-USER-ID".

Appellant argues that Fortenberry does not teach "in response to the vendor location receiving and processing the unique code". The examiner disagrees and directs appellants' attention to col 8, lines 40 through 47 where the vendor is submitting a message from the user containing a specific release type based on a unique "MY-USER-ID".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues that the combination of Fortenberry and Hartman does not teach "automatically inserting by the vendor at least a portion of the stored profile information of the user into the vendor payment form". The combination of Fortenberry and Hartman clearly teach "A structured document with spaces reserved for entering

information and often containing special coding as well". In this case the structured document is pre-filled with information such as credit card and shipping address that would normally be filled in by the buyer on the structured form.

In regards to claims 4 and 17 appellant argues that the combination of Fortenberry and Hartman does not teach "wherein the vendor location receives the profile information from the second location in response to the vendor location transmitting the unique code to the second location. The examiner disagrees and directs the appellants' attention to FIG 5 Item 506 and col 8, lines 37-52, where it is clear that the vendor is submitting a unique code to a the second location (pass port agent) in response to a unique code "MY-USER-ID".

In regards to claims 5, 6 and 19, appellant argues that the combination of Fortenberry and Hartman does not teach that there is a unique ID that is sent to the vendor from the user. The examiner disagrees and directs the appellants' attention to FIG 5 Item 506 and col 8, lines 37-52, where it is clear that the vendor is submitting a unique code to a the second location (pass port agent) in response to a unique code "MY-USER-ID".

In regards to claims 7 and 20 appellant argues that the combination of Fortenberry and Hartman does not teach inserting, causes all the profile information to be inserted in the form as encoded information. The examiner disagrees and directs the appellants' attention to Hartman where all the information is filled in a form before the form is sent to the user for verification (Hartman, FIG 1C)

In regards to claim 8 and 21 appellant argues that the combination of Fortenberry and Hartman does not teach inserting only a portion of the profile information to be entered in the vendor payment form as encoded information. The examiner disagrees and directs the appellant's attention to the payment method that disguises the payment method by only inserting a portion of the information.

In regards to claims 11 and 24, appellant argues that neither Fortenberry nor Hartman teaches a central server. The examiner disagrees and directs appellant's attention to at least Fortenberry and the PASSPORT server.

In regards to claims 12 and 25, the appellant argues the examiner's use of Official Notice and asks that the examiner provide a reference. To support the Official Notice the examiner provides Wong which teaches receiving unique codes issued to a user (col 11, lines 1-15) that can be redeemed by a merchant (claim 11) through a bank/credit card company (col 10, lines 50-60 and col 5, lines 30-45).

Appellant argues that the combination of Fortenberry and Hartman does not teach a unique code placed on a credit card. The examiner notes that as admitted by appellant on page 45 of the Appeal Brief, Rhoads teaches "a steganographically encoded object disposed on a credit card".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Further, hindsight is not improper if the combination would yield predictable results to one of ordinary skill in that art (MPEP 2143).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has used teachings, suggestion of motivation that was well known in the art.

Further, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness.

In response to applicant's argument that Fortenberry, Hartman and Rhoads is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for

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rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all of the references Fortenberry, Hartman and Rhoads deal with the purchasing of product over the internet.

In regards to claims 28 and 29, appellant argues that the combination of Fortenberry, Hartman and Rhoads does not teach a form being filled out. The examiner disagrees and directs the appellant's attention to arguments supra regarding forms and there use in Hartman and Fortenberry.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Mark Fadok/

Primary Examiner, Art Unit 3625

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